

REMARKS

The present communication is responsive to the Official Action mailed January 13, 2005, finally rejecting all the claims currently pending in the application, namely, claims 1-7 and 10-19. Of the pending claims, claims 1, 6, 11 and 16 are independent base claims. All the remaining claims depend from one of the independent base claims.

A petition for a two-month extension of the term for responding to the Official Action, to and including June 13, 2005, is filed concurrently herewith.

Claim 6 has been amended to improve its form and now recites "a register for setting codes of functions to be executed by the electronic device." Applicant respectfully submits that the amendment to claim 6 does not constitute the addition of new matter to the application.

The Examiner rejected claim 6 under 35 U.S.C. §112, first paragraph, as "failing to comply with the enablement requirement." (Official Action at 2.) Specifically, the Examiner asserts that "There is nothing in the specification that teaches changing a requested function in the code in the read and write area of the register matches" (*Id.*) Applicant respectfully submits that paragraphs 0028-0031 clearly provide antecedent support for the subject matter of claim 6.

The Examiner also rejected claim 6 under 35 U.S.C. §112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (*Id.*) In particular, the Examiner did not understand what is meant by "changing the code of a requested function when the code in the read and write area matches." (*Id.*) Applicant respectfully submits that claim 6 is clear in reciting that "wherein the requested function can be changed if the code of the function written in the write area is same as the code of the function

read from the read area." For a better understanding of the claim language, applicant respectfully requests that the Examiner review, for example, paragraphs 0028-0032 of the specification.

Applicant respectfully submits that claim 6 meets all the requirements of 35 U.S.C. §112 and requests withdrawal of the rejections under §112.

The Examiner rejected claims 1-7 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,164,549 to Richards ("*Richards*"). With regard to claims 1, 6, 11 and 16, the Examiner asserts that while "*Richards* does not explicitly teach a read and write are[a] in the register (memory)," *Richards* teaches all the other limitations of these claims. (Official Action at 3.) The Examiner concludes, therefore, that "it would have been obvious to one of ordinary skill in the art at the time of the invention that the memory must have read and write areas in order to receive the new function command and compare the command against the directory of functions already in the card." (*Id.*)

Applicant respectfully traverses the Examiner's rejections.

*Richards'* invention and disclosure is directed to the problem of making IC cards compatible among different IC card standards. (*Richards*, col. 1, lns. 50-59). *Richards'* disclosure and "invention solves the aforementioned problems by introducing a 'shell' application that executes 'on top' of the operating system and that handles the implementation of IC card standards that are not compatible with the initially loaded operating system of the IC card." (*Id.*, col. 1, ln. 66-col. 2, ln. 3.) Further in that regard, *Richards* states "According to the presently claimed invention, however, a manufacturer may produce an IC card with a single operating system and execute different shell applications to implement the different

standards." (Id., col. 6, lns. 38-42.) In that regard, an integrated circuit 12 on the IC card 10 controls the operations of the IC card, including the flow charts illustrated in FIGS. 5-9. Richards clearly states "FIGS. 5A-9 are flowcharts illustrating a preferred embodiment of IC card operating system routines capable of supporting a shell application." (Id., col. 6, lns. 43-45.) Thus, Richards' IC cards operating system uses a shell program or application that enables operability among different IC card standards. In Richards' scheme, "The shell application then returns any response to the operating system in the proper format for transmission to the terminal." (Richards, col. 7, lns. 1-3.) Thus, by Richards' disclosure, the IC card controls processing and ensures interoperability, not the terminal or main unit.

In contrast, claim 1 recites "controlling, by the main unit, execution of the requested function." Further in that regard, the steps of comparing and determining as recited in claim 1 are also carried out by the main unit.

Claim 6 recites "the register including a write area in which the code of a function requested by the main unit is written, and a read area in which the code of a function selected in an electronic device is read and detected by the main unit to enable changing of the requested function by the main unit."

Claim 11 recites "wherein the main unit recognizes that the requested function is installed in the electronic device if the code of the function written in the write area is the same as the code of the function read from the read area."

Claim 16 recites "wherein the main unit is adapted to write a code of a function requested by the main unit in the write area, to read a code of a function to be executed from the read area and to control execution of the requested function in the electronic device based on the read code."

Thus, in each of the limitations quoted above with respect to claims 1, 6, 11 and 16, it's the main unit that controls execution of a requested function. In contrast, by *Richards'* scheme, it's the IC card or electronic device that "execute different shell applications to implement the different standards." (*Richards*, col. 6, lns. 38-42.) Thus, *Richards'* entire disclosure teaches completely opposite to the claimed invention. In fact, the teachings of *Richards* are cumulative to that which is taught in U.S. Patent 5,901,303 to *Chew*. The *Chew* reference was withdrawn as a result of applicant's amendment filed on September 30, 2004. *Richards* suffers from the same deficiencies as *Chew*.

The fact that the Examiner continues to find and rely on new references (i.e., *Richards*) that teach nothing new to references already relied on (i.e., *Chew* and the other references previously cited and relied on) makes it abundantly clear that the claims are not only novel, as conceded by the Examiner, but are clearly not obvious.

In addition, the Examiner's statement that "*Richards* does not explicitly teach a read and write are[a] in the register (memory)" misses the mark entirely. Not only is that feature of the claimed invention not "explicitly" taught in *Richards*, but all the processing in *Richards* is controlled by the IC card. In that regard, the Examiner's rejection completely ignores major portions of the claim (for example, see the quoted portions of claims 1, 6, 11 and 16 above). But it is these ignored portions that are, more importantly, not taught or suggested by the prior art of record.

Therefore, applicant respectfully submits that independent claims 1, 6, 11 and 16 are clearly allowable for at least the foregoing reasons. Inasmuch as all the other claims pending in the application depend from the independent claims,

those claims are also allowable for at least the foregoing reasons.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 13, 2005

Respectfully submitted,

By 

Orville R. Cockings

Registration No.: 42,424

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant